Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte

BETH N. GRIJALVA

Appeal No. 2005-0213
Application No. 09/594,445

ON BRIEF

Before GARRIS, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon a careful review of the record in this appeal, we determine that this application is not in condition for a decision at this time. Accordingly, pursuant to our authority under 37 CFR § 41.50(a)(1)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)), we remand this application to the jurisdiction of the examiner for action consistent with our remarks below.

Claims 12, 26 and 42 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Heaford in view of Grindle (final Office

action dated Nov. 27, 2002, Paper No. 13, page 3; Answer, page 4). Claims 49-51 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Grindle in view of Mosher (*id.*). Appellant recognizes that claims 12, 26, 42 and 49-51 have been rejected as "obvious" (Brief, pages 9-10). However, appellant has failed to present any specific arguments or comments on any section 103(a) rejection, and has not discussed or mentioned the Mosher reference (see the Brief in its entirety). Furthermore, appellant has not corrected these deficiencies in any Reply Brief. Accordingly, appellant's Brief is not in compliance with 37 CFR § 1.192(c)(8)(iv)(2002). Therefore, upon return of this application to the jurisdiction of the examiner, the examiner should inform appellant of this defect in the Brief and require correction within the prescribed time period. *See MPEP,* § 1206, 8th ed., Rev. 2, May 2004.

Upon the return of this application to the jurisdiction of the examiner, the examiner and conferees should specifically state what rejections are pending in this appeal. The final rejection included two rejections under the second paragraph of 35 U.S.C. § 112 (final Office action dated Nov. 27, 2002, Paper No. 13, page 2). These rejections under section 112, ¶2, were <u>not</u> repeated in

the Answer (see the Answer, pages 1-5). *See Paperless Accounting v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986)(Rejections not repeated in the Answer may be considered as withdrawn by the examiner). Although, the rejection of claims 46-51 under section 112, paragraph two, apparently should have been withdrawn due to the amendment entered after the final rejection, this rejection has not been explicitly withdrawn on this record (see Paper No. 13, page 2; the amendment dated May 9, 2003, Paper No. 15; and the Advisory Action dated May 21, 2003, Paper No. 16). Furthermore, appellant presents arguments against the rejections under section 112, paragraph two (Brief, pages 18-19), and the examiner and conferees reply to these arguments in the Answer (page 7) even though the section 112 rejections are not set forth in the answer. Therefore, upon return of this application to the jurisdiction of the examiner, the examiner and the conferees should clarify the record as to the status of the rejections based on section 112, paragraph two.

This application, by virtue of its "special" status, requires an immediate action; *see MPEP*, § 708.01 (D)(8th ed., Rev. 2, May 2004, p. 700-126). It is important that the Board of Patent

Appeals and Interferences be promptly informed of any action affecting the appeal in this application.

REMANDED

BRADLEY R. GARRIS)
Administrative Patent Judge)
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THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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PETER F. KRATZ)
Administrative Patent Judge)

TAW/jrg

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Fred G. Pruner Jr
Trop Pruner & Hu PC
8554 Katy Freeway Suite 100
Houston, TX 77024